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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,203	03/10/2004	Phil Stewart	420624	4179

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LATHROP & GAGE LC
2345 GRAND AVENUE
SUITE 2800
KANSAS CITY, MO 64108

EXAMINER

HORTON, YVONNE MICHELE

ART UNIT	PAPER NUMBER
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3635

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/06/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/797,203	Applicant(s) STEWART, PHIL	
	Examiner Yvonne M. Horton	Art Unit 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 5-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-19,21,23,24,26-33 is/are rejected.
- 7) ☒ Claim(s) 20,22 and 25 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claim 5 is objected to because of the following informalities: In claim 5, line 1, the claim is introduced with "5.." however, this should be --5.-- . Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 30 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 30, it is not clear how the tile is "bacteriostatic". There is nothing in the claim indicating identification of such other than the word "bacteriostatic". Clarification is required.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1,2,5,7,11,13,16,19,24,25 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent #4,885,882 to FORSHEE. FORSHEE discloses a tile cap (18) that fits over an existing tile surface (12) and is adhered thereto using an adhesive, column 2, lines 57-58. Regarding claims 2 and 25, the cap (18) is resin plastic, column 2, lines 41-46. Regarding claims 5,7 and 24, the existing surface is

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wood, column 2, lines 29-30 and is flat. In reference to claims 11 and 13, the adhesive is an epoxy glue which is known in the art as a construction adhesive. Regarding claims 16 and 33, the cap (18) is decorative. In reference to claim 19, the cap (18) is applied without grout.

Claim 24 is rejected under 35 U.S.C. 102(b) as being anticipated by US Patent #3,953,268 to DILLON. DILLON discloses the method of using a tile cap (21) wherein the tile cap (21) is positioned over an existing tile (16).

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 6,8-10,12,14,15,17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #4,885,882 to FORSHEE. FORSHEE discloses the basic claimed tile cap except for certain materials the cap is made of, certain materials the existing surface is made of, and certain adhesive material. Although FORSHEE is silent in this regard, it would have been obvious to one having ordinary skill in the art at the time the invention was made to select a known material suitable for the use intended as an obvious matter of design choice. For instance, in environments where there may be extremely heavy loads imparted thereon or traffic thereon, the structure needs to be durable, and as such, perhaps a ceramic base is sufficient. Also, on the other hand, ceramic bases, at times are a lot more slippery than wood, and it would be valuable to provide the ceramic structure with a mechanism to prevent slipping thereon. Furthermore, the applicant has shown no criticality for the selection of any one type of a

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material over another. Thus, the selection of either would have been an obvious matter of design choice.

Claims 21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #3,953,268 to DILLON. DILLON discloses the method of using a tile cap (21) wherein the tile cap (21) is positioned over an existing tile (16). DILLON discloses the basic claimed method except for explicitly detailing that his tile is ceramic. Although DILLON is silent in this regard, it would have been obvious to one having ordinary skill in the art at the time the invention was made that his tile is ceramic. Furthermore the selection of any known material suitable for the use intended is an obvious matter of design choice. Regarding claim 23, the applicant has shown no criticality for the selection of any one type of adhesive material over another. Thus, the selection of either would also have been an obvious matter of design choice.

Claims 26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent #3,953,268 to DILLON. DILLON discloses the basic claimed method except for explicitly detailing the specifics of material used. Although DILLON is silent in this regard, it would have been obvious to one having ordinary skill in the art at the time the invention was made to select a known material suitable for the use intended is an obvious matter of design choice. Furthermore, the applicant has shown no criticality for the selection of any one type of material over another. Thus, the selection of either would also have been an obvious matter of design choice.

Claims 30-32 are rejected, as best understood, under 35 U.S.C. 103(a) as being unpatentable over US Patent #3,953,268 to DILLON. DILLON discloses the method of

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using a tile cap (21) wherein the tile cap (21) is positioned over an existing tile (16).

DILLON discloses the basic claimed method except for explicitly detailing that his tile is ceramic/bacteriostatic or except for indicating that his adhesive is double sided.

Although DILLON is silent in this regard, it would have been obvious to one having ordinary skill in the art at the time the invention was made that his tile is ceramic/bacteriostatic. Furthermore the selection of any known material suitable for the use intended is an obvious matter of design choice. Regarding the adhesive, the applicant has shown no criticality for the selection of any one type of adhesive material over another. Thus, the selection of either would also have been an obvious matter of design choice.

Allowable Subject Matter

Claims 20,22 and 25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot-in-part in view of the new ground(s) of rejection. Regarding the applicant's argument that the tile members of FORSHEE are not tile because they are wood, there is nothing precluding a wood member from being a tile. As a matter of fact, even the applicant's ladder claims identify his tile as being made from wood.

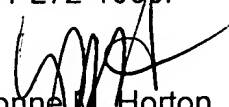
Conclusion

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yvonne M. Horton whose telephone number is (571) 272-6845. The examiner can normally be reached on 6:30 am - 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman can be reached on (571) 272-6842. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Yvonne M. Horton
Art Unit 3635
04/02/07